

REMARKS

In the Office Action, the Examiner rejected claims 1-28, 31, and 32. By this paper, Applicants have amended claims 1, 2, 4, 5, 7, 8, 11, 12, 14, 17, 18, 21-27, 31, and 32 for clarification of certain features to expedite allowance of the present application. These amendments do not add any new matter. Additionally, claims 29 and 30 have been canceled. Upon entry of these amendments, claims 1-28, 31, and 32 are pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejection under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(a) as being anticipated by Challenger (U.S. Pub. No. 2003/0174842, hereafter “the ‘842 reference”). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir.1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir.1990). That is, the prior art reference must show the *identical invention* “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki*

Motor Co., 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Applicants need only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

The present application is directed to providing a methodology for operating multiple security modules, such as TPMs, in a computer. *See* paragraph [0016]. In addition to other benefits, the operation of multiple TPMs within a computer may provide redundancy of keys. *See* paragraphs [0033]-[0034]. As such, claim 1, as amended recites, *inter alia*, “A method of operating a first security module *in a computer*, the method comprising the acts of: detecting a second security module *in the computer*.” (Emphasis added).

In sharp contrast, the ‘842 reference does not disclose operating a first security module in a computer and a second security module in the same computer as set forth in claim 1. The ‘842 reference is directed to migrating a private key from a client computer to a server so that the key can be distributed to other client computers as determined by a system administrator. *See* ‘842 reference, paragraphs [0010]-[0013]. As such, it discloses a TPM 22 in a client computer 12 and a TPM 40 in a sever 16. *See* Fig. 1. However, the ‘842 reference fails to disclose a method of operating a first security module *in a computer* and detecting a second security module *in the computer* as set forth in claim 1.

For at least this reason, the '842 reference cannot anticipate claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(a) and allowance of claim 1.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 2-3, 6-10, 13-16, 19-23, and 26-32 under 35 U.S.C. § 103(a) as being unpatentable over the '842 reference; and rejected claims 4-5, 11-12, 17-18, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over the '842 reference in view of Challener et al. (U.S. Publication No. 2003/0105965, hereafter referred to as "the '965 reference"). Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974) (emphasis added). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the

Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

As mentioned above, the present application is directed to providing a methodology for operating multiple security modules, such as TPMs, in a computer. *See* paragraph [0016]. In addition to other benefits, the operation of multiple TPMs within a computer may provide redundancy so that if one of the TPMs fails another TPM can unseal information sealed by the failed TPM. *See* paragraphs [0033]-[0034].

As such, independent claims 8 and 14, as amended recite, *inter alia*, “A security module *in a computer*” and “another security module *in the computer*.” (Emphasis added). Independent claim 21, as amended recites, *inter alia*, “A computer comprising...a first security module and a second security module.” (Emphasis added). Independent claim 31, as amended recites, *inter alia*, “A computer network, comprising...a plurality of computers; *at least one of the plurality of computers* comprising: a first security module; and a second security module.” (Emphasis added).

As discussed earlier, the ‘842 reference is directed to migrating a private key from a client computer to a server so that the key can then be distributed to other client computers as determined by a system administrator. *See* ‘842 reference, paragraphs [0010]-[0013]. As such,

the '842 reference discloses a TPM 22 in a client computer 12 and a TPM 40 in a sever 16. *See* Fig. 1. However, the '842 reference does not disclose multiple TPMs in the same computer.

Specifically, the '842 reference does not disclose a security module in a computer and a second security module in the computer as set forth in claims 8 and 14. The '842 reference does not disclose a computer comprising a first security module and a second security module as set forth in independent claim 21. The '842 reference does not disclose at least one of a plurality of computers comprising a first security module and a second security module as set forth in independent claim 31. For at least these reasons, the '842 reference does not make obvious the independent claims 8, 14, 21, and 31 under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of independent claims 8, 14, 21, and 31, as well as all claims depending thereon.

The '965 reference fails to obviate the deficiencies of the '842 reference with respect the independent claims 1, 8, 14, 21, and 31. Specifically, the '965 reference is directed to a business method for sharing keys across a network. *See* Abstract. The '965 reference fails to disclose multiple security modules in a computer as set forth in the independent claims of the present application. As such, the '842 reference and the '965 reference, taken alone or in hypothetical combination, fail to disclose all the elements of independent claims 1, 8, 14, 21, and 31. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

Allowable Subject Matter

In the Office Action, the Examiner objected to claims 29 and 30 as being dependent upon a rejected base claim, but stated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants would like to thank the Examiner for indicating the potential allowability of these claims.

Although Applicants do not believe that the Examiner's rejections were proper, Applicants have chosen to amend claim 27 to place it in condition for allowance by incorporating the subject matter of claims 29 and 30. In making these amendments, however, Applicants reserve the right to continue prosecution of the original claims in a continuation application.


Accordingly, Applicants believe that claim 27 is in condition for allowance. Furthermore, Applicants assert that claim 28 is allowable based on its dependency from claim 27.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: July 5, 2006



Michael G. Fletcher
Registration No. 32,777
Fletcher Yoder
7915 FM 1960 West, Suite 330
Houston, TX 77070
(281) 970-4545